

R E M A R K S

Claims 1 through 15 are in the application, with Claims 1-7, 10-12, and 15 having been amended. No new matter has been added. Reconsideration and further examination are respectfully requested.

Claim Rejections – 35 USC § 101

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 has been amended to recite a tangible result of “providing the determined advertising information from the user device to the user” in view of the Examiner’s helpful comments.

Claim Rejections – 35 USC § 112

Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have also been amended in view of the Examiner’s helpful comments.

Claim Rejections – 35 USC § 102

Claims 1-2, 5-7, 10-12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Skillen et al. (US 6, 098,065).

Claim 1 recites “locally determining at a user device advertising information based on (i) contextual information associated with remote information being accessed by a user, and (ii) supplemental information associated with the user.” By way of example, an advertising application 114 executing at a user device 110 (*e.g.*, a user’s personal computer) may determine advertising information (*e.g.*, FIG. 1 and Specification at page 8, lines 1 to 10).

Skillen discloses that an advertising machine 30 (including a contextual database 46, product database 42, and user profile database 48) at an access provider equipment site 32 may

select advertising information (Skillen at FIG. 2 and col. 5, lines 18 to 28).¹ That is, the advertising information is not selected at the end user device 12 (as might be the case in the method of claim 1 of the present application).

March also does not disclose “locally determining at a user device advertising information based on ... contextual information associated with remote information being accessed by a user.” Because the references do not disclose or suggest such a feature, Applicants respectfully request reconsideration of these rejections.

Claim Rejections – 35 USC § 103

Claims 3-4, 8-9, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (US 6,876,974). In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although “the suggestion more often comes from the teachings of the pertinent references,” *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir.1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.

Applicants respectfully suggest that the Examiner has not provided a reasonable motivation to modify Marsh and/or Skillen in such a way as to result in the invention as recited in the claims. According to the Office Action:

It would have been obvious to one of ordinary skill ... to include that advertising information is provided to the user when the user device is not communicating via the communication network ... because it would advantageously allow to avoid the downloaded during the on-line access advertisements become “stale”, thereby

¹ FIG. 1 of Skillen similarly discloses that the advertisement selection is performed remote from (and not local to) an end user device 12. That is, the decision is made on the other side of the communications link 14.

avoid the risk of user being number or otherwise negatively
affected as a result of overexposure....

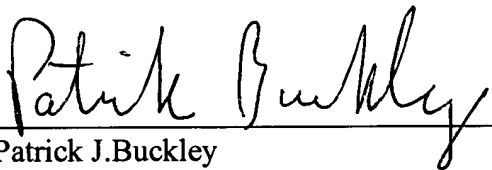
Office Action at page 7, second paragraph. Applicants respectfully disagree and suggest that these references in no way suggest modifying any system to produce a method as recited in claim 1. Because there is no teaching or suggestion to modify the references in that particular way, a *prima facie* case of obviousness has not been established.

CONCLUSION

Accordingly, Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-0191.

Respectfully submitted,

January 10, 2007
Date


Patrick J. Buckley
Registration No. 40,928
Buckley, Maschoff & Talwalkar LLC
50 Locust Avenue
New Canaan, CT 06840
(203) 972-0191